

REMARKS

Upon entry of this paper, claims 1, 2, and 5 have been amended, no claims have been canceled, and no claims have been added as new claims. Thus, claims 1-5 are presently pending in this application. No new matter has been added.

Specification Recommendations

Applicant thanks the Examiner for the detailed summary of the guidelines for the preferred layout and content for patent applications. However, Applicant believes that the Preliminary Amendment filed January 2, 2002, and the Response filed March 18, 2004 have adequately addressed the format of the application, and have followed the recommended guidelines. Accordingly, Applicant provides no additional amendments to the Specification at this time, other than the paragraph relating the priority information as confirmed by the Official Filing Receipt. Should the Examiner wish to have any further amendments made to the Specification, the Examiner is hereby invited to specifically detail such changes.

Applicant has added Related Applications information to the beginning of the Specification to properly refer to the priority acknowledged in the filing receipt of the pending Application.

Claim Rejections under 35 U.S.C. §112

Claims 1-5 were rejected under 35 U.S.C. §112, paragraph 1, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Applicant respectfully traverses this rejection in view of the following comments.

According to MPEP Manual of Patent Examining Procedures § 2163, “[p]ossession may be shown in a variety of ways including . . . showing that the invention was "ready for patenting" such as by the disclosure of drawings . . . that show that the invention was complete . . .” See, e.g., Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641,

1647 (1998); Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406; Amgen, Inc. v. Chugai Pharmaceutical, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991)

Furthermore, “[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”)”.

Applicant respectfully submits that the Examiner has not met the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. Specifically, the Examiner merely states that “it is not clear how to alter a conventional/commercially available faceplate, usually used in an ITE or CIC hearing aid and in rather small size, to provide a side plate of a BTE hearing aid.” See OA, paragraph 3.

Applicant respectfully submits that which the Examiner claims is not clear is specifically described and depicted in the Specification and Figures. The Specification states with regard to this element of the invention that, “This front plate may easily be mounted on top of the housing shell of the BTE device to be produced, the technical components being accommodated by the housing shell. Any remaining overhanging edges of the front plate, which is usually made of plastic and easily worked, are ground off.” See Specification, page 2, lines 5-8. The Specification further states that, “[t]he manufacturer of the front plates simply modifies the injection mold for the plastic so as to match the contour of the front plate to the contour of the housing shell. Insertion of devices into the front plate so modified may thus be accomplished by the manufacturer in precisely the same ways as with previous conventional front plates.” See Specification, page 2, lines 13-16. In addition, the Specification states that, “the front plate may be initially fabricated with the larger dimensions, fitted with the electronic components, and subsequently adapted in a cost-effective manner to the contour of the housing shell of a BTE device, for example, by using an automated punch or milling procedure. Excess material may then be removed before the front plate and housing shell are joined while retaining optimal

accessibility of the front plate and without risking damage to the housing shell.” See Specification, page 2, lines 22-28.

The Figures 5 and 6 specifically show the combination of the conventional ITE faceplate 4 coupled with the BTE housing shell 1, which is significantly larger than the prior art ITE housing shell (as known by those of ordinary skill in the art). The faceplate 4 is the same size for both the BTE application and the ITE application. This is illustrated by the relative difference between the size of the BTE housing shell 1 relative to the standardized faceplate 4 in Figure 5, and the size of the ITE housing shell 2 relative to the standardized faceplate 2 in US Patent No. 6,430,296. The present invention makes use of the standardized faceplate for use with the ITE, but rather than using the faceplate for the ITE, the present invention couples the same standardized faceplate with the BTE, which is clearly illustrated.

Applicants further provide the following one-to-one comparison between claim 1, and the Description and Figures.

Claim 1: A behind the ear hearing aid (Figs. 1-3), comprising a housing having a housing shell configured in a contoured shape (Figs. 1-3), an electronic circuit, a power storage unit, and a multi-function plate designed as a front plate (Fig. 4 and page 3, lines 22-30) and adapted to couple to the housing shell by being shaped to match the contoured shape (Figs. 5 and 6), wherein the multifunction plate includes an access opening (Fig. 4) for one of the power storage unit and the electronic circuit.

Each of the above-described methods for forming the face plate to match the contours of the BTE shell make use of manufacturing methods that are known to those of ordinary skill in the art. In addition, each of the above-described figures clearly shows the coupling of the standardized faceplate with the BTE in accordance with the present claimed invention. Accordingly, Applicant has adequately described the invention to the extent necessary to support the claims under 35 U.S.C. §112.

Applicant respectfully requests reconsideration and withdrawal of all 35 U.S.C. §112 rejections.

CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Applicant courteously solicits allowance of the claims in the form of a Notice of Allowance. Should there be any further outstanding issues of patentability following the entry of this amendment, a telephone interview is respectfully requested to resolve such issues.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized to be charged to the aforementioned Deposit Account. A duplicate copy of this sheet is enclosed.

Dated: August 2, 2004

Respectfully submitted,

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